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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,941	02/28/2005	Ulrike Licht	266110US0XPCT	2567
22850	7590	03/06/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/06/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/525,941

Applicant(s)

LICHT ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 7/10/08 has been entered.

The amendment of 7/10/08 has been entered. Claims 9-17 are pending.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what the basis of the claimed percentage of monomers is intended to be. It is noted that "40% of the monomers of the polyadduct" may be based on either weight or moles, which give different bases. The applicant's argument that the originally filed language "40% of the monomers" is correct does not remedy this lack of clarity since it remains unclear if 40% by weight of the monomers is intended or 40% by moles of the monomers is intended. The contradiction between the applicant's prior and present arguments further adds to the lack of clarity of this language. The argument that 40% is a ratio value and therefore is correctly stated as a number value ignores the fact that such a ratio may also be and is often used as a weight value, as previously argued in this application. The originally filed application provides no basis for the applicant's current argument that the percentage is a number value.

In prior prosecution, the applicant argued in essence that the specification supports the use of “by weight” citing sections relating to the amounts of components used in the composition being referenced by weight percent, e.g. page 8, line 47, page 9, line 18, page 12, line 7, and page 13, line 8. However, none of these sections refer to the claimed percentage, e.g. the amount “of the monomers of the polyadduct [that] have reacted to form the polyadduct.” All of the percentages referring to the amount “of the monomers of the polyadduct [that] have reacted to form the polyadduct” are expressed in % and recite no basis for the percent, such as weight, molar, volume, etc.. It is not seen that the amounts referenced in the applicant’s arguments as weight percentages are also intended to be basis for the claimed amount “of the monomers of the polyadduct [that] have reacted to form the polyadduct” to be expressed in weight percent. The argument that amounts of reactants consumed in reactions are typically expressed in molar percentages and the applicant’s use of “mol%” at page 6, line 27 to account for amounts of “polyadduct” reactants might equally apply. The applicant has not addressed this issue. Thus, one cannot tell what basis the applicant intended for the claimed limitation of claim 9 at issue in the above rejection. While the specification certainly recites “weight basis”, it also recites “mol%” though neither are recited with regard to the limitation in question in the instant claims. Thus, it is not seen that the instant specification describes the claimed amount “of the monomers of the polyadduct [that] have reacted to form the polyadduct” in weight percent or mole percent. In any event, the instant claims do not recite either basis. It is improper to read limitations from the specification into the claims, particularly so when the basis cannot be determined adequately, as discussed above, from the specification. Arguments regarding Beers law are noted but these arguments do not clarify whether the claimed percentage is by weight or molar basis and the

argued values of Beers law can be expressed in either basis based on rudimentary considerations of chemistry, e.g. the relationship between moles and weight.

The applicant's arguments have been fully considered but are not persuasive for the above stated reasons. It is not seen how the ordinary skilled artisan would know the basis of the claimed percentage since it is not stated in the instant claims, which therefore do not particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is impermissible to read limitations from the specification into the claims. The instant specification does not state what the basis of the instantly claimed percentage is. As noted above, the argued IR method result can be given in mole% or weight% based in rudimentary considerations, e.g. the relationship of weight to moles. This rejection is therefore maintained.

4. Claims 9-17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action for reasons of record.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796